Remarks

This Application has been carefully reviewed in light of the Office Action mailed June 16, 2004. Applicant appreciates the Examiner's consideration of the Application. Applicant has made clarifying amendments to Claims 1, 12, 23, and 34-35. None of these amendments are considered narrowing or necessary for patentability. Applicant also respectfully provides these remarks. Applicant respectfully requests reconsideration and allowance of all pending claims.

I.   Clarification Regarding the Office Action Summary

The Office Action Summary indicates that only Claims 1-22 are pending in the Application and that only Claims 1-22 are rejected. For clarity of the record, Applicant notes that Claims 1-35 are pending in the Application and that the Examiner rejected each of Claims 1-35 in the Office Action.

II.   Claims 1-22 and 35 Comply with 35 U.S.C. § 112, Second Paragraph

The Examiner rejects Claims 1-22 and 35 under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter Applicant regards as the invention. Applicant respectfully disagrees.

In particular, the Examiner states that there is no structure to the claims. Applicant respectfully disagrees. For example, Claim 1 recites, "An electronic commerce system providing market feedback to sellers, the system comprising a server operating on one or more computers and operable to" perform certain limitations recited in the body of the claim. The system recited in Claim 1 (and its dependent claims) clearly comprises a server operating on one or more computers. The M.P.E.P. states, "Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation." M.P.E.P. § 2111.02 citing *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 U.S.P.Q.2d 1962, 1966 (Fed. Cir. 1989) Thus, Applicant respectfully submits that it would be improper to state that "there is no structure to the claims."

Additionally, the Examiner states, "[T]he preamble of the claims sets forth an apparatus, however the body includes only method step limitations. Examiner notes that MPEP 2114 states that while features of an apparatus may be recited either structurally or functionally, claims

directed to an apparatus must be distinguished from the prior art in terms of structure rather than function." (Office Action, Page 2) Applicant respectfully submits that the rejections of Claims 1-22 and 35 under 35 U.S.C. § 112, second paragraph, is improper because the scope of the claims would be clear to one of ordinary skill in the art at the time of invention. More particularly, Applicant believes that the statements made by the Examiner with respect to the rejection of Claims 1-22 and 35 under 35 U.S.C. § 112, second paragraph, and the citation of M.P.E.P. § 2114 would be more appropriately discussed in the art rejections and do not support a rejection under 35 U.S.C. § 112, second paragraph. Applicant notes that the essential inquiry pertaining to the definiteness requirement is whether the claims set out and circumscribe subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (a) the content of the particular application disclosure; (b) the teachings of the prior art; and (c) the claim interpretation that would be given by one possessing ordinary skill in the art at the time the invention was made. M.P.E.P. § 2173.02. Furthermore, the test for indefiniteness under Section 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." M.P.E.P. §2173.02 (citing *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)). Applicant respectfully submits that the meaning of Claims 1-22 and 35 would certainly be clear to one of ordinary skill in the art at the time of invention such that these claims comply with 35 U.S.C. § 112, second paragraph.

Furthermore, taking the Examiner's apparent position to the extreme, any system claim that recites a memory and a processor, the memory storing certain information and the processor operable to perform certain functions, would be anticipated by any reference that discloses a memory and a processor because the structure of the claim would be disclosed by the reference (regardless of whether the operations are disclosed). This result simply cannot be the rule. System claims that involve computers and the operation of computers generally focus on the operations and functions performed by the computers in the system. Computers must be programmed to perform certain functions, using one or more of programmed software, firmware, or hardware. It simply is not the case that any reference that discloses a processor and memory anticipates a claims that includes a computer.

Moreover, Claims 12-22 are directed to software operable to perform certain functions. Such claims are clearly definite. With respect to claims directed to software, the M.P.E.P. states that "a claimed computer-readable medium encoded with a computer program [is] statutory." M.P.E.P. § 2106(IV)(B)(1)(a). While this portion of the M.P.E.P. is particular to patentable subject matter, it makes clear that the M.P.E.P. contemplates and authorizes claims directed to software embodied in a computer-readable medium and operable to perform certain functions. As discussed above, Claim 17 is directed to "software" that is "embodied in computer-readable media and when executed operable to" perform certain functions, which according to the M.P.E.P. is statutory. The only way to define such software is by reciting limitations in the body of the claim that specify what the software, when executed, is operable to perform. In addition, M.P.E.P. § 2106(V)(A)(2) states, "Applicants should be encouraged to functionally define the steps the computer will perform rather than simply reciting source or object code instructions." Applicant respectfully submits that one of ordinary skill in the art would certainly be able to ascertain the metes and bounds of the invention recited in Claims 12-22 directed to software. Thus, Claims 12-22 are clearly definite.

The scope of the claims is reasonably ascertainable by those skilled in the art and thus the claims are not indefinite. *See* M.P.E.P. § 2173.05(e); *see also Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992). Applicant respectfully requests the Examiner to withdraw the rejections of Claims 1-22 and 35 under 35 U.S.C. § 112.

III. Applicant's Claims are Allowable over *Mathur*

The Examiner rejects Claims 1-35 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,581,072 to Mathur et al. ("*Mathur*"). Applicant respectfully disagrees.

At the outset, Applicant notes that the Examiner has merely summarized *Mathur* and concluded that all of Applicant's claims are anticipated by *Mathur* rather than note which *specific* teachings in *Mathur* are purportedly relevant to *each element* of *each of Applicant's claims* and why such teachings of the references are purportedly relevant. As such, Applicants have been forced to speculate as to which portions of *Mathur* the Examiner equates with which limitations recited in Applicant's claims.

Mathur merely discloses a system that includes a search engine that provides a search tool for allowing users to identify documents of interest using information stored in an index generated by the search engine. (Column 3, Lines 33-35) To identify documents of interest, a user configures a query using a client computer. (Column 3, Lines 35-37) The query may contain query terms (e.g., "Thai" and "cooking") which describe, for example, a topic or concept (e.g., Thai cooking) about which the user is interested in finding more information. (Column 3, Lines 37-43) A search engine executing on a remote server may receive the query and identify documents (or locations of the documents) that match or satisfy the query based on information stored in the index used by the search engine. (Column 3, Lines 46-50) Information identifying the relevant documents or their locations (e.g., web pages identified by their URLs) determined by the search engine is then communicated from the search engine server to the user's client computer, and the user may then user the information received from the search engine to access one or more of the relevant documents. (Column 3, lines 52-57; Column 4, Lines 15-16)

Mathur further discloses that conventional search engines frequently track and/or mine the user's browsing activities and track information provided by the user to the search engine. (Column 4, Lines 32-34) *Mathur* discloses the example that several conventional search engines mine, without the user's permission, information contained in user search queries (which may contain information of a sensitive and private nature) provided to the search engines and contents of documents (e.g., web pages) accessed by the user using the search engine. (Column 4, Lines 34-41) As an example of the latter, *Mathur* discloses that conventional search engines track the web pages accessed by the user, the content of the web pages, transactions performed by the user using the web pages, and other like information without the user's permission. (Column 4, Lines 41-45) *Mathur* further discloses that the information mined or tracked is used to ascertain information about the user's interests, likes/dislikes, the user's shopping preferences, information related to the user's use of the Internet, and other information related to the user and the user's behavior. (Column 4, Lines 46-50) *Mathur* further discloses that the user information collected by the search engines and the user profile information built by the search engines may be distributed or even sold by providers of search engines to entities such as advertising agencies, government agencies, insurance companies, and business entities. (Column 4, Lines 55-61)

At best, the above disclosures of *Mathur* merely disclose a search engine that resolves a user's search queries for web documents, presents the results to the user, and tracks certain information related to the user's requests and selection of documents. However, *Mathur* fails to disclose, teach, or suggest at least the following limitations specifically recited in Claim 1 as amended, for example:

- record query information associated with *a search query for a buyer of one or more databases containing product data*;
- *record presentation information associated with presentation of a plurality of search results to the buyer, each search result comprising data for a product matching one or more search criteria specified in the search query, the search results comprising one or more search results reflecting product data for a particular seller*;
- record selection information associated with *selection by the buyer of a particular search result from among the plurality of search results, the particular search result comprising data for a particular product matching one or more search criteria specified in the search query*; and
- *provide at least some of the recorded query information, presentation information, or selection information to the particular seller to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers*.

For example, *Mathur* fails to disclose, teach, or suggest a server operable to "record query information associated with *a search query for a buyer of one or more databases containing product data*," as recited in Claim 1. *Mathur* merely discloses a user submitting a search query for one or more web documents (e.g., web pages). *Mathur* further discloses that several conventional search engines mine information contained in user search queries provided to the search engines. However, nowhere do the cited portions of *Mathur* disclose, teach, or suggest queries of product databases containing product data, let alone a server operable to "record query information associated with *a search query for a buyer of one or more databases containing product data*," as recited in Claim 1. Rather, the cited portion of *Mathur* appears to be concerned merely with conventional search engines such as Yahoo, Google, Lycos, Excite, Altavista, and the like, searching for web pages matching search queries. (*See* Column 2, Line 63 through Column 3, Line 2)

As another example, *Mathur* fails to disclose, teach, or suggest "*record presentation information associated with presentation of a plurality of search results to the buyer, each search result comprising data for a product matching one or more search criteria specified in*

the search query, the search results comprising one or more search results reflecting product data for a particular seller," as recited in Claim 1. *Mathur* discloses that a search engine executing on a remote server may receive the query and identify documents (or locations of the documents) that match or satisfy the query based on information stored in the index used by the search engine. (Column 3, Lines 46-50) Information identifying the relevant documents or their locations (e.g., web pages identified by their URLs) determined by the search engine is then communicated from the search engine server to the user's client computer. (Column 3, lines 52-57; Column 4, Lines 15-16) *Mathur* further discloses that several search engines track the contents of documents (e.g., web pages) accessed by the user using the search engine (e.g., the web pages accessed by the user, the content of the web pages, and transactions performed by the user using the web pages). (Column 4, Lines 38-44)

First, nothing in these cited portions discloses anything related to recording presentation information, let alone a server operable to "*record presentation information associated with presentation of a plurality of search results to the buyer,*" as recited in Claim 1. Applicant notes that the Examiner has not indicated which particular disclosure in the cited portion of *Mathur* that the Examiner believes discloses "presentation information" as recited in Claim 1. In any event, Applicant respectfully submits that tracking contents of documents access by the user using the search engine, the content of the web pages, and transactions performed by the user using the web pages (as disclosed in *Mathur*) have nothing to do with "presentation information associated with presentation of a plurality of search results to the buyer," let alone recording such presentation information as recited in Claim 1. Second, the cited portions of *Mathur* merely disclose tracking information related to search queries for *web documents*. Nowhere does *Mathur* disclose, teach, or suggest "*each search result comprising data for a product matching one or more search criteria specified in the search query, the search results comprising one or more search results reflecting product data for a particular seller,*" as recited in Claim 1.

As another example, because *Mathur* fails to disclose, teach, or suggest "search results" as recited in Claim 1, *Mathur* necessarily fails to disclose, teach, or suggest a server operable to "record selection information associated with *selection by the buyer of a particular search result from among the plurality of search results, the particular search result comprising data for a particular product matching one or more search criteria specified in the search query,*" as

recited in Claim 1 as amended. The cited portions of *Mathur* do not even mention data for a particular product, let alone "the particular search result [a search result selected by the buyer] comprising data for a particular product matching one or more search criteria specified in the search query," as recited in Claim 1 as amended.

As another example, *Mathur* fails to disclose, teach, or suggest a server operable to "***provide at least some of the recorded query information, presentation information, or selection information to the particular seller to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers***," as recited in Claim 1. *Mathur* merely discloses that the user information collected by the search engines and the user profile information built by the search engines may be distributed or even sold by providers of search engines to entities such as advertising agencies, government agencies, insurance companies, and business entities. (Column 4, Lines 55-61) Even assuming for the sake of argument that *Mathur* disclosed, taught, or suggested recorded query information, presentation information, or selection information (which, as discussed above, it does not), *Mathur* would still fail to disclose, teach, or suggest a server operable to "***provide*** at least some of [the information] ***to the particular seller***," let alone "***provide*** at least some of [the information] ***to the particular seller to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers***." The deficiencies of *Mathur* with respect to disclosing query information, presentation information, and selection information as recited in Claim 1 are made even more clear given that the type of information distributed or sold by the search engine providers as disclosed in *Mathur* would not "allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers," as recited in Claim 1. For example, merely distributing or selling information regarding a particular user's interests (e.g., browsing habits as recorded in a user profile) likely would not "allow the particular seller," which itself is not even disclosed in *Mathur*, "to assess one or more aspects of its product data [also not disclosed in *Mathur*] relative to product data of other sellers," as recited in Claim 1.

Applicant respectfully notes, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, "[t]he identical invention must be

shown in as complete detail as contained in the . . . claim." M.P.E.P. § 2131 citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Furthermore, "[t]he elements must be arranged as in the claim under review." *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990); M.P.E.P. § 2131. As illustrated above, *Mathur* fails to disclose, either expressly or inherently, each and every limitation recited in Applicant's Claim 1, as is required under the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1 and its dependent claims.

For at least the reasons stated with regard to Claim 1, Applicants respectfully request reconsideration and allowance of independent Claims 12, 23, and 34 and their dependent claims.

With respect to Applicant's dependent claims, as discussed above, the Examiner merely summarized certain of *Mathur's* disclosures and then rejected Applicant's claims as being anticipated by *Mathur*. The Examiner has apparently ignored many of the limitations recited in Applicant's claims, and particularly in Applicant's dependent claims, which are clearly not disclose, taught, or suggested by *Mathur*. This is particularly relevant given that the rejection is an anticipation rejection, which, as discussed above, requires that each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Applicant respectfully submits that independent Claim 35 is allowable for substantially similar reasons to those discussed above with reference to independent Claim 1. In addition, *Mathur* fails to disclose, teach, or suggest a server operable to perform the following limitations recited in Claim 35, as amended:

- record query information associated with a search query for a buyer of one or more databases containing product data, *the query information reflecting one or more product attribute values and one or more seller attribute values specified in the search query*;
- record presentation information associated with presentation of a plurality of search results to the buyer, each search result comprising data for a product matching one or more search criteria specified in the search query, the search results comprising one or more search results reflecting product data for a particular seller, *the presentation information reflecting a position of a search result for the particular seller within an ordered display of the search results*; and

- record selection information associated with selection by the buyer of a particular search result from among the plurality of search results, the particular search result comprising data for a particular product matching one or more search criteria specified in the search query, *the selection information reflecting*:

  > *whether the buyer considered one or more search results for the particular seller;*

  > *one or more product attribute values or seller attribute values for one or more search results for the particular seller considered but not selected by the buyer;*

  > *a position of a search result for the particular seller within an ordered display of the search results;* and

  > *one or more product attribute values or seller attribute values for the search result selected by the buyer;* and

- *a position of the selected search result within the plurality of search results presented to the buyer.*

Given that the Examiner did not indicate where in *Mathur* the above-indicated limitations are purportedly disclosed, Applicant concludes that the Examiner did not give patentable weight to these limitations. If Applicant's conclusion is incorrect, Applicant would appreciate the Examiner clarifying the Examiner's position in the next Office Action by indicating what disclosures in *Mathur* the Examiner believes disclose these limitations. Applicant reiterates that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, "[t]he identical invention must be shown in as complete detail as contained in the . . . claim." M.P.E.P. § 2131 citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Furthermore, "[t]he elements must be arranged as in the claim under review." *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990); M.P.E.P. § 2131. Thus, Applicants respectfully submit that the Examiner must give patentable weight to all limitations in Claim 35. In any event, *Mathur* fails to disclose, teach, or suggest at least the above-indicated limitations recited in Claim 35.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 35.

IV.   <u>No Waiver</u>

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the *Mathur* reference. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Applicant believes no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant

Christopher W. Kennerly
Reg. No. 40,675

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Correspondence Address:
Baker Botts L.L.P.
2001 Ross Avenue, 6th Floor
Dallas, Texas 75201-2980
Tel. (214) 953-6812

Customer No.: **05073**